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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/543,164 04/05/00 BILLINGTON

G 07703-332001

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PM82/0719

EXAMINER

SHAPIRO, J.

ART UNIT

PAPER NUMBER

3651

**DATE MAILED:**

07/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/543,164	BILLINGTON ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Jeffrey A. Shapiro	3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 April 2000.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6 &amp; 7</u>	6) <input type="checkbox"/> Other: _____

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in Application No. 09/543,164, filed on 04/05/00.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Morun (US 5,566,807). Morun discloses the vending machine as follows.

As described in Claims 1 and 8-10, 12, 14-18, 20-24 and 26;

1. a vending machine (1) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further operable in response to determining that insufficient change is available (see figure 8, element 900), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 9, element 1002) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount (see figure 7),

3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 5, elements (420 and 430));

As described in Claims 2, 8, 17 and 19-21, 25 and 27;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (95) (see also col. 11, lines 3-24);

As described in Claim 3;

5. the warning indication is provided only if the allowable overpay amount is non-zero (note that the warning indication as described in col. 11, lines 3-24 will not be provided where the customer submits an amount that is the price of the item desired).

As described in Claim 4;

6. said predetermined criterion is met when the available change is less than the value of the lowest denomination non-refundable payment unit (see figure 8);

As described in Claims 5 and 8;

7. said vending machine is operable to provide an "exact change" indication to a customer when a requested vend is inhibited (again, note display (95), thereby providing ability and capability to display such information);

As described in Claims 6, 11 and 28;

8. the machine is operable, when inhibiting a vend, to permit the customer to request a vend at a different price (note that the customer is capable of requesting a vend at a different price when the machine becomes disabled (1106)).

As described in Claim 7;

9. the machine is operable to reject a non-refundable payment unit in response to determining that accepting the unit would result in the difference between a credit value and the amount of refundable change exceeding said predetermined allowable overpay amount (see figure 8);

As described in Claim 13;

10. the circumstances giving rise to the second indication also cause the deposited monetary unit to be refunded (see figures 10a and 10b);

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Tedesco et al (US 6,085,888). Tedesco et al discloses the vending machine as follows.

As described in Claims 1 and 8-10, 12, 14-18, 20-24 and 26;

1. a vending machine (100) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;

2. a vending machine further operable in response to determining that insufficient change is available (see figure 8a, element 820), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 8a, element 822), depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount. Therefore, any amount above the item price is predetermined to be an overpay.)

3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 1b, noting processor (144) which necessarily allows input and storage of item prices);

As described in Claims 2, 8, 17 and 19-21, 25 and 27;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figure 8a, elements (820 and 822));

6. Claims 1-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Ramsey et al (US 6,055,521). Ramsey et al discloses the vending machine as follows.

As described in Claims 1 and 8-10, 12, 14-18, 20-24 and 26;

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1. a vending machine (35) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further operable in response to determining that insufficient change is available (see figures 5, 15a and 15b), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend, depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount. Therefore, any amount above the item price is predetermined to be an overpay.)
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (note that PC (27) necessarily allows input and storage of item prices);

As described in Claims 2, 8, 17 and 19-21, 25 and 27;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figures 5, 15a and 15b);

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Teicher (US 5,728,999) and (US 6,102,162); Martin et al; Brown et al; Tedesco et al (US 5,988,346) are all cited as examples of customer transaction systems.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P. Ellis can be reached on (703)308-2560. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-0552 for regular communications and (703)308-0552 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Jeffrey A. Shapiro  
Patent Examiner,  
Art Unit 3651

  
C.P. Ellis 7/16/01

July 15, 2001

CHRISTOPHER P. ELLIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600